

REMARKS

I. Status of the Claims

Claims 2-47, 51, 52, 54-58, and 60-62 are pending. Claims 1, 48-50, 53, and 59 were previously canceled.

Claims 2, 26, 29, 30, 34, 51, 52, 54, 55, 58, 61, and 62 have been amended by this document.

Claim 2 has been amended to recite, *inter alia*, "wherein the one or more wagering entries each comprise a set of randomly generated numbers."

Claim 26 has been amended to recite, *inter alia*, "wherein each of said one or more wagering entries comprises a set of the plurality of random generated numbers."

Claims 54 and 61 have been amended to recite, *inter alia*, "the data store storing a plurality of sets of generated random numbers of a prepaid wagering medium." Claim 58, which depends from claim 54, has been similarly amended to recite "sets of generated random numbers."

Support for the amendments to claims 2, 26, 54, 58, and 61 can be found throughout the as-filed specification and claims, for example, at page 4 in paragraph [0018], at page 8 in paragraph [0039], at pages 15-16 in paragraphs [0067]-[0068], and in original claim 26.

The amendments to claims 29, 30, 34, 51, 52, 55, and 62 corrected minor informalities and do not affect the scope of the claims.

Thus, Applicants submit that the above amendments raise no issue of new matter.

II. Interview Summary

Applicants' representative thanks the Examiner for the courtesy of the interview granted on August 15, 2008. It is noted that the Examiner's supervisor was unable to take part in the interview at the scheduled interview time and was therefore not present. During the meeting with the Examiner, Applicants' representative provided examples of prepaid wagering cards according to the present invention. In addition, Applicants' representative provided the Examiner a copy of the claim amendments presented above. Applicants' representative discussed the claim amendments with the Examiner and pointed out the deficiencies in the prior art that the Examiner relied upon in the rejection of the claims as set forth in the final Office Action mailed June 4, 2008. The Examiner indicated that the claim amendments would be favorably considered in an after-final amendment.

Applicants request that, prior to action on this amendment after-final, the Examiner contacts Applicants' representative to make this interview officially of record.

III. Arguments

A. Nulph in view of Katz

The Examiner has rejected claims 2-22, 24, 25, 27-29, 31, 38-46, 52, 54, 55, 58, 60, and 61 under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,203,011 to Nulph ("Nulph") in view of U.S. Patent Application Publication No. US 2003/0060261 to Katz et al. ("Katz"). Applicants respectfully disagree and traverse the rejection for at least the following reasons.

1. The Rejections Are Not Clearly Articulated

It is noted that the Examiner states that the rejection identified above is made over Nulph in view of Katz, but the assertions made by the Examiner refer to Stoken and Protheroe, as well. See *Office Action* at the paragraph bridging page 2 to page 3 and the last full paragraph on page 5. For example, the Examiner refers to a teaching of Katz and then states that it would have been obvious to combine the teachings of Protheroe and Nulph to arrive at the claimed invention without ever stating the teachings of Protheroe that are being relied upon.

M.P.E.P. § 706 states that the goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. M.P.E.P. § 706 (emphasis added). Because the Examiner has not clearly identified the rejection by referring to references not identified in the rejection, Applicants respectfully request the withdrawal of the finality of the rejection and clarification by the Examiner to allow Applicants to reply completely to the Office Action.

Applicants also note that the Examiner rejected claims 27-29 over Nulph in view of Katz, but did not reject claim 26, the independent claim from which claims 27-29 depend, under the combination of Nulph in view of Katz. Because claims 27-29 contain all of the limitations of the base claim from which they depend, the rejection of claims 27-29 is improper. Similarly, the Examiner rejected dependent claims 31 and 38-46, dependent claim 52, and dependent claims 55 and 58 over the combination of Nulph and Katz without rejecting the base independent claims 30, 51, and 54 over the same combination of references. (Note: The Examiner indicated that independent claim 54

was rejected under 35 U.S.C. § 103(a) over the combination of Nulph and Katz, but did not address the claim in the rejection. The Examiner did address independent claim 54 under the 35 U.S.C. § 103(a) rejection over the combination of Nulph and Leason et al. Thus, the Examiner provided no basis for the rejection of independent claim 54 over the combination of Nulph and Katz.) Because the rejection of dependent claims 27-29, 31, 38-46, 52, 55, and 58 are improper for failure to reject the base independent claims from which they depend, Applicants respectfully request the withdrawal of the rejection.

2. The Requirements Of 35 U.S.C. § 103 Are Not Met

To establish a *prima facie* case of obviousness, the Examiner must show that three basic criteria have been met. See M.P.E.P. § 2143. Specifically, the Examiner must establish: (1) that the prior art teaches or suggests all of the elements of the claims; (2) that there is some teaching or suggestion in the prior art to modify the prior art so as to arrive at the presently claimed invention; and (3) that one of ordinary skill in the art at the time the invention was made would have had a reasonable expectation of success in making the asserted modification. *Id.* For at least the following reasons, the Examiner has failed to meet this burden.

Regarding independent claim 2, the Examiner alleges, *inter alia*, that Nulph discloses a wagering card that includes a plurality of random numbers. *Office Action* at 3. The Examiner further states, in reference to claim 58, that the system of Nulph is interpreted as having a random number generator that generates a plurality of random numbers. *Office Action* at 6. Applicants disagree.

Nulph discloses a ticket that may be used for a lottery system. Nulph, however, fails to disclose a prepaid wagering card comprising one or more wagering entries,

wherein the one or more wagering entries each comprise a set of randomly generated numbers, as recited in the present claims. Nulph states:

The controlling authority 120 also transmits to the user 160 data to the user 160 including instructions as to how to modify the ticket so that it will reflect the data relative to play sent by the user 160. As part of this process, the controlling authority 120 will modify the record corresponding to the ticket in the database 122 to record 126 any play data exchanged between the user 160 and the controlling authority 120. Such play data could include, for example, such things as lottery play numbers chosen by the user 160.

See *Nulph* at col. 4, ll. 36-47. Nulph further describes the process with respect to a lottery by stating that a ticket for a "lottery on command" game would have a plurality of game number play spots and only play spots uncovered by the user would indicate the lottery number that the user desires to play using the ticket. *Nulph* at col. 6, ll. 12-30.

Thus, the ticket of Nulph requires interaction between the user and the controlling authority to modify the ticket to have a wagering entry, e.g. lottery numbers. The present claims recite a prepaid wagering card comprising one or more wagering entries "wherein the one or more wagering entries each comprise a set of randomly generated numbers."

Accordingly, Nulph fails to teach or suggest each and every element of claim 2. Claims 3-22, 24, and 25 are ultimately dependent on claim 2 and therefore include all of the elements recited in claim 2. Independent claims 26, 54, and 61, and thus the claims dependent thereon, also recite at least one set of generated random numbers associated with a prepaid wagering card. Therefore, Nulph also fails to teach or suggest each and every element of claims 3-22, 24, 25, 27-29, 55, 58, and 60.

Katz fails to cure the deficiencies of Nulph because Katz neither teaches nor suggests a prepaid wagering card having one or more wagering entries comprising a set of randomly generated numbers.

For at least the foregoing reasons, Applicants submit that the rejection of claims 2-22, 24, 25, 27-29, 31, 38-46, 52, 54, 55, 58, 60, and 61 is improper and respectfully request the withdrawal of the rejection.

B. Nulph in view of Leason

The Examiner has rejected claims 26, 28, 30, 32, 33, 36, 37, 47, 51, 54-57, and 62 under 35 U.S.C. § 103(a) as allegedly unpatentable over Nulph in view of U.S. Patent No. 6,251,017 to Leason et al. ("Leason"). Applicants respectfully disagree and traverse the rejection for at least the following reasons.

The Examiner acknowledges that Nulph fails to teach the use of a non-traditional lottery terminal as a point of sale for a pre-paid wagering card. *Office Action* at 8. The Examiner asserts that Leason provides a lottery card game wherein the point of sale terminal may be a non-traditional lottery terminal. *Id.* The Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the method of Nulph "in order to increase the sales of the prepaid cards by attracting more or repeat customers." *Id.* at 8. Applicants respectfully disagree.

Applicants respectfully submit that the combined teachings of Leason and Nulph fail to teach all of the limitations recited in the present claims. Independent claim 26 recites "providing a prepaid wagering card processing system configured to register the identification information of the prepaid wagering card when the prepaid wagering card

is purchased at a point of sale terminal ... wherein the point of sale terminal comprises a non-traditional lottery terminal." Independent claims 30 and 51 recite "providing a prepaid wagering card processing system configured to register the identification information of the prepaid wagering card when the prepaid wagering card is purchased at a traditional lottery retailer having a dedicated lottery sales terminal or at a non-traditional lottery retailer having a general sales terminal."

One of ordinary skill in the art would readily appreciate that the lottery card game taught by Leason is not a wagering card. The lottery card game of Leason is a promotional card or sales receipt given to a customer as a reward when a non-related purchase is made. The reward can later be validated online or over the phone. See *Leason*, entire disclosure. The promotional card or sales receipt is not purchased by the customer. As such, the game card of Leason has nothing to do with gambling or wagering.

The pre-paid wagering card of the present invention is a form of gambling. As stated in the present disclosure, "only retailers who register with a State's lottery can accept wagers and distribute scratch card games." See *Specification* at par. [0004]. Federal law defines a lottery as any game, contest, or promotion that combines the elements of prize, chance, and consideration. In layman's terms, consideration is the "price" one must pay to participate and is commonly monetary. The game card of Leason is not a wagering card for a lottery because it is a reward and does not require consideration. The Examiner's assertion that it would have been obvious to modify the teachings of Nulph because Leason teaches non-traditional lottery terminal for a game card can only be based on improper hindsight. Leason does not provide any teaching

or suggestion to use a non-traditional lottery terminal for anything other than a game card.

Further evidence of the Examiner's use of improper hindsight comes from the Examiner's assertion that it would have been obvious to combine the teachings of Nulph and Leason "in order to increase the sales of the prepaid cards by attracting more or repeat customers." Nulph teaches that the controlling authority issues the tickets to a distributor such as a convenience store that sells lottery tickets. *Nulph* at col. 3, ll. 63-66. Thus, Nulph teaches distribution through a traditional lottery retailer. Leason is silent with respect to selling at a traditional lottery retailer. In fact, Leason does not even disclose the sale of wagering cards. In the disclosure of Leason, customers make an independent purchase and receive goods in exchange for consideration. Therefore, the assertion by the Examiner that it would have been obvious to combine the teachings of Nulph and Leason to increase sales has no support in the teachings of either Nulph or Leason and is based on improper hindsight because it uses Applicants' invention as a roadmap.

Therefore, Leason does not disclose the sale of a prepaid wagering card at a non-traditional lottery retailer and thus fails to cure the deficiencies of Nulph. The combined teachings of Nulph and Leason fail to teach all of the limitations recited in the present claims.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

IV. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 2-47, 51, 52, 54-58, and 60-62 in condition for allowance. Applicants submit that the proposed amendments to claims 2, 26, 29, 30, 34, 51, 52, 54, 55, 58, 61, and 62 do not raise new issues. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of this amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 50-4126.

Respectfully submitted,

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